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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,492	10/29/2001	Matthew Steward Gebhard	A01125	7481

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/055,492

Applicant(s)

GEBHARD ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/29/01;02/12/02;06/06/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to an aqueous coating composition, classified in class 524, subclass 375.
  - II. Claims 6-10, drawn to a method of coating, classified in class 427, subclass 385.5.
2. The inventions are distinct, each from the other because:
3. Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the aqueous coating composition(product), as claimed, can be used in a materially different process such as a process which involves extrusion into a free-standing film.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Mr. Gregory Hill on June 11, 2002 a provisional election was made WITH traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-10 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

8. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Claim Objections

9. Claim 4 is objected to because of the following informalities: In claim 4. (a) (ii), second occurrence, "(ii)" should read "(iii)". Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "having a water solubility of less than 8%" per claims 1 and 5 and "having a water solubility of at least 8%" per claim 4 constitutes indefinite subject matter as per the entity that such is based on, i.e., weight % or else, is not readily ascertainable.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rokowski et al(U.S. 5,534,310).

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Rokowski et al disclose a latex binder suitable for producing high gloss coating, with improved adhesion, on weathered substrates which include architectural coatings, such as exterior house paints, mastics and caulks, and industrial maintenance coatings for metal, such as exposed structural steel on bridges, above-ground storage tanks, etc., which are exposed to incident sunlight and outdoor conditions and coatings which are exposed to incident sunlight such as a building, marble and terrazzo, concrete, stone floors, etc. and a method for producing such coatings. More specifically, Rokowski et al disclose a coating composition comprising a latex binder comprising an aqueous evaporable carrier having dispersed therein a latex polymer(governed by an acid number of 1 to 70 and an average particle size of 30 to 800 nanometers and most preferable, 80 to 200 nanometers) derived from a) 2 to 20 wt.% of at least one acetoacetyl functional monomer such as acetoacetoxymethyl methacrylate(sufficient to meet the component (i) per claim 4 ), b) 0.2 to 10 wt.% of acid functional monomer such as acrylic acid, methacrylic acid, etc.(sufficient to meet the copolymerized acid monomer component per claims 1 and 4) and optionally, at least one monomeric or polymeric acrylic or methacrylic acid ester such as methyl acrylate, methyl methacrylate, ethyl acrylate, ethyl methacrylate, propyl acrylate, propyl methacrylate, butyl acrylate, butyl methacrylate, 2-ethyl hexyl acrylate, 2-ethyl hexyl methacrylate, decyl acrylate, decyl methacrylate, hydroxyethyl acrylate, hydroxyethyl methacrylate, hydroxypropyl acrylate, hydroxypropyl methacrylate and combinations thereof, at least one polymeric or monomeric alkene such as ethylene or at least one vinyl monomer or polymer such as acrylamide, acrylonitrile, 1,2-butadiene, 1,3-butadiene, chloroprene, 1,3,5-hexatriene, styrene, alpha-methyl styrene, vinyl acetate, vinyl chloride, vinyl toluene, vinyl versatate, vinylidene chloride or combinations thereof(which includes monomers sufficient to meet the ethylenically unsaturated nonionic monomers having a water solubility of less than 8%, and at least 8% per claims 1 and 4), provided that any such additional optional ingredient is addition-polymerizable with the aforementioned acetoacetoxymethyl functional moiety and the acid moiety-containing components, and 0% to 2% of an ureido functional monomer may be included in the latex polymer for further improvements in adhesion to substrates. Rokowski et al, @ the paragraph bridging cols. 6 & 7, further teach that the latex binder may comprise additional ingredients such as polymer thickeners, surfactants, polymeric flow modifying ingredients and various dispersion or emulsion polymers and solution polymers and that the latex polymers suitable for use in the present invention may be prepared by well known polymerization techniques, such as suspension polymerization and emulsion polymerization of ethylenically unsaturated, emulsion polymerization being preferred. See, e.g., the Abstract, the paragraph bridging cols. 1 and 2, cols. 4-16, Runs inclusive, col. 17, lines 1-32 and the claims of Rokowski et al. More specifically, Rokowski et al exemplify aqueous coating compositions containing at least 0.8 grams(1.6 wt.%, according to the Examiner's calculations) of Triton X 405(an alkylphenol

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ethoxylate, sufficient to meet the nonionic surfactant per claims 1 and 4), 495.4 grams of Latex Polymer IV governed by a particle size of 90 nanometers and derived from butyl acrylate(57 wt.%), methyl methacrylate(41 wt.%) and acrylic acid(2.5 wt.%), 494.8 grams of Latex Polymer V governed by a particle size of 91 nanometers and derived from butyl acrylate(54.0 wt.%), methyl methacrylate(43.5 wt.%) and acrylic acid(2.5 wt.%) or 499.6 grams of Latex Polymer VI governed by a particle size of 97 nanometers and derived from butyl acrylate(51.0 wt.%), methyl methacrylate(38.5 wt.%), acetoacetoxy ethyl methacrylate(8.0 wt.%) and acrylic acid(2.5 wt.%) wherein the Latex polymers IV, V and VI overlap in scope with the emulsion polymer per claim 1 and Latex polymer VI overlaps in scope with the emulsion polymer per claim 4. See Runs 4, 5, 6 and 8. Therefore, Rokowski et al anticipate the instantly claimed invention with the understanding that Latex Polymers having acid numbers and particle sizes(claims 3 and 5) falling within the scope of the claimed invention would have been readily envisaged following the guidelines of Rokowski et al @ col. 5, lines 23-38 and 58-64 who teach equivalent latex polymers having acid nos. of from 1 to 70 and particle sizes of from 30 to 800 nanometers and with the understanding that the glass transition temperature(Tg) of the exemplified polymers may very well meet the claimed glass transition temperature limitations since the Latex Polymers of Rokowski et al are essentially the same as and made under essentially the same conditions as the claimed emulsion polymer and in the absence of the USPTO to have at its disposal the tools or facilities deemed necessary to make physical determinations of this sort. The onus to show that this, in fact, is not the case is shifted to applicants to prove otherwise as per In re Best et al, 195 USPQ 430. The "consisting essentially of" transitional phrase per claims 1 and 4 only precludes those components that would materially alter the basic and novel characteristics of the claimed invention(Ex parte Davis, 80 USPQ 448 and In re Janakirama-Rao(317 F 2d 951, 137 USPQ 893).

As to the claimed property "having improved adhesion to friable surfaces, it would be reasonably expected to be possessed by the aforementioned, aqueous coating compositions of Rokowski et al since it is well settled that when a claimed product reasonably appears to be substantially the same as the product disclosed in the prior art, the burden of proof is on applicants to prove that the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product(In re Spada, 15 USPQ 2d 1655(CAFC 1990)).

Even if it turns out that the claimed invention(1-5) is not anticipated, it would have been obvious to the skilled artisan to extrapolate the aqueous coating composition per claims 1-5 from Rokowski et al as per such having been within the general purview of the disclosure of Rokowski et al and with a reasonable expectation of success, with the understanding that the selection of monomer(s) in both content and character so as to arrive at the claimed Tg is well within the skill of the routine

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worker in the art and the so called "improvement of adhesion to friable surfaces" would necessarily flow from the suggestion in the prior art to make the modification(Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985)).

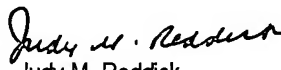
Conclusion


15. The additional prior art to Suen et al(U.S. 3,284,394), Rogers(U.S. 3,320,196), Shea(U.S. 3,594,337), Christena(U.S. 3,637,563), Settlage et al(U.S. 3,701,745), Reed(U.S. 3,738,991), Haag et al(U.S. 4,345,044), Gebhard et al(U.S. 5,623,085) and Hsu et al(U.S. 5,616,419) listed on the attached FORM PTO 892 is cited as of interest in teaching the combination of a latex polymer derived from ethylenically unsaturated monomers and a nonionic surfactant such as Triton X 405, said art considered merely cumulative to the prior art supra and the remaining additional prior art made of record and not relied upon is cited as of being illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
9.2.03